

REMARKS**Summary of the Office Action**

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Hayashi (U.S. Pub. No. 2002/0013531) (hereinafter "Hayashi").

Claims 1-6 stand provisionally rejected under the judicially created doctrine of non statutory obviousness-type double patenting as being unpatentable over claim 1 of co-pending application no. 11/629,471.

Summary of the Response to the Office Action

Applicants have amended independent claim 1, and dependent claims 2 and 6, to differently describe embodiments of the disclosure of the instant application. Applicants have canceled claim 3 without prejudice or disclaimer. Accordingly, claims 1, 2 and 4-6 remain currently pending and under consideration.

Double Patenting Rejection

Claims 1-6 stand provisionally rejected under the judicially created doctrine of non statutory obviousness-type double patenting as being unpatentable over claim 1 of co-pending application no. 11/629,471. Applicants have amended independent claim 1, and dependent claims 2 and 6, to differently describe embodiments of the disclosure of the instant application. As a result, the double patenting rejections have been rendered moot by these claim amendments. Accordingly, Applicants request that the double patenting rejections be withdrawn.

Rejection under 35 U.S.C. § 102(b)

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Hayashi. Applicants have amended independent claim 1, and dependent claims 2 and 6 to differently describe embodiments of the disclosure of the instant application. In addition, features of previous dependent claim 3 have been added to newly-amended independent claim 1. As a result, Applicants have canceled claim 3 without prejudice or disclaimer. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that independent claim 1 of the instant application has been newly-amended to describe a combination of features of a lymph node detecting apparatus that includes:

- (1) the optical filter transmits the fluorescence image, and in addition, transmits the reflection image of the excitation light at a predetermined light intensity;
- (2) the image pickup means is a single image pickup device; and
- (3) the observation image, in which a fluorescence picture image that corresponds to the fluorescence image and a normal picture image that corresponds to the reflection image of the excitation light are overlapped, is obtained by the single image pickup device.

In the above features (1) to (3), the feature (1) is based on description in original Claim 3, and the feature (2) is based on, for example, the configuration of the lymph node detecting apparatus shown in Fig. 1.

For the feature (3), Applicants respectfully submit that there is a description in paragraph [0038] of the specification that “[o]ptical filter 3, which selectively transmits fluorescence image 11 from among the light from living body observation portion 20, may transmit, at a

predetermined light intensity, a reflection image from living body observation portion 20 illuminated by excitation light 10," and "an observation image, such as shown in FIG. 4(c), in which a fluorescence picture image, such as shown in FIG. 4(a) that corresponds to a fluorescence image, and a normal picture image, such as shown in FIG. 4(b) that corresponds to a reflection image, are overlapped, can thereby be obtained."

In the lymph node detecting apparatus of the present invention, by using the above configuration, Applicants respectfully submit that the "ascertainment of the position of sentinel lymph node 21 in living body observation portion 20 can thereby be facilitated," as described, for example, in paragraph [0038] of the specification of the instant application.

Further Applicants respectfully submit that the "adjustments of the observation image" by the adjusting means "are especially useful in the case where the optical filter, which transmits, in addition to the fluorescence image (fluorescence picture image), the reflection image (normal picture image) from the living body observation portion at the predetermined intensity, is used," as described, for example, in paragraph [0042] of the specification of the instant application.

For example, Applicants respectfully submit that by "performing an adjustment of enhancing the contrast on this video signal as shown in FIGS. 6(b) and 7(a), an image in which the lymph node appears clearly can be obtained", and also, "by performing an adjustment of enhancing the luminance as shown in FIGS. 6(c) and 7(b), the position of the lymph node in the living body observation portion can be ascertained clearly from the image in which the normal picture image and the fluorescence picture image are overlapped," as described, for example, in paragraph [0043] of the specification of the instant application. Please see, for example, paragraphs [0038], [0042], and [0043] of the specification of the instant application.

Applicants respectfully submit that the configuration of the lymph node detecting apparatus of the present invention, including at least the above-described features, is neither disclosed, nor even suggested, in the applied Hayashi reference.

More particularly, Applicants respectfully submit that in the configuration shown in Fig. 2 of Hayashi, a near-infrared cutoff filter 122, which cuts off light having a wavelength of 700 nm or larger, and a near-infrared cutoff filter 126, which cuts off light having a wavelength of 820 nm or smaller, are utilized as optical filters. In addition, Applicants respectfully submit that the excitation light in Hayashi has a wavelength of 790 nm. As a result, Applicants respectfully submit that the optical filter, which transmits, in addition to the fluorescence image, the reflection image of the excitation light, is not utilized in the configuration of Hayashi.

Therefore, Applicants respectfully submit that it is clearly understood that the observation image, in which a fluorescence picture image and a normal picture image are overlapped, cannot be obtained using the single image pickup device arrangement disclosed in Hayashi. In addition, Applicants respectfully submit that the observation image, in which a fluorescence picture image and a normal picture image are overlapped, cannot be obtained by the single image pickup device arrangement also disclosed in the configuration illustrated in Fig. 5 of Hayashi.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because Hayashi does not teach or suggest each feature of newly-amended independent claim 1 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

Furthermore, Applicants respectfully assert that the dependent claims 2 and 4-6 are allowable at least because of their dependence from independent claim 1, and the reasons discussed previously

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims currently under consideration are in condition for allowance, and respectfully request reconsideration and timely allowance of these claims.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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